

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q66579

Fumio SUGAYA, et al.

Appln. No.: 10/042,319

Group Art Unit: 1743

Confirmation No.: 4442

Examiner: Latoya I. CROSS

Filed: January 11, 2002

For: INCUBATOR

RESPONSE UNDER 37 C.F.R. § 1.111

MAIL STOP AMENDMENT

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In response to the Office Action dated March 9, 2006, please amend the above-identified application as follows on the accompanying pages.

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REMARKS

STATUS OF CLAIMS:

Claims 1-6 are pending in the application. Claims 3 and 4 are withdrawn from consideration as being directed to non-elected subject matter.

35 U.S.C. § 112:

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 112, second paragraph. Claim 1 recites a “correction means.” As an initial matter, Applicant thanks the Examiner for the interview of May 11, 2006. The substance of the interview and Applicant’s response is noted in the below remarks.

In particular, the Examiner asserts that Applicants have invoked 112, 6th paragraph, which requires that a corresponding structure be described in the specification and equivalents thereof. Applicant respectfully submits that the meaning of equivalents is well understood in patent law and the “specification need not describe the equivalents of the structures, material, or acts corresponding to the means- (or step-) plus-function claim element.” See MPEP §2182 and *In re Noll*, 545 F.2d 141, 149-50, 191 USPQ 721, 727 (CCPA 1976).

In regard to structure in the specification which correlates to the claimed mean-plus-function, Applicant points out that “[t]he proper test for meeting the definiteness requirement is that the corresponding structure or material or acts of a means or step-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure or material or acts will perform the recited function.” See MPEP § 2181; and *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999).

Also, “the disclosure of the structure or material or acts may be implicit or inherent in the specification if it would have been clear to those skilled in the art what structure or material or acts corresponds to the means or step-plus-function claim limitation.” See MPEP § 2181; *Atmel Corp. v. Information Storage Devices, Inc* at 1380, 53 USPQ2d at 1229; and *In re Dossel*, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997).

The present specification does disclose what structure, material or acts will perform the recited function. For example, the present specification describes, *inter alia*, the following:

"As shown in FIG. 3, the optical density of the dry analysis element 11 as measured by the light measuring head 41 is sent to an operating section 42 and is corrected by a *correction means* 43 on the basis of a correction value which has been stored for the position of each element chamber 33 (for the distance of each element chamber 33 from the light measuring head 41 when the element chamber 33 is in the light measuring position). The correction means 43 is provided with a correcting section 44." (Emphasis added.)

See page 14, lines 10-18 of the specification.

Thus, corresponding structure, material or acts related to the claimed correction means are disclosed in the specification. Also, the description is provided in a way that one skilled in the art will understand what structure, material or acts will perform the recited function. The correction means 43 is also illustrated in the exemplary embodiment of Figure 3. Page 14 of the present specification describes that the optical density of the dry analysis element 11, measured by the light measuring head 41, is corrected by the correction means 43.

A skilled artisan will realize that the correction means comprises an "electric circuit," such as an operational circuit, and, thus, structure corresponding to the claimed correction means would be understood by one of ordinary skill in the art. Therefore, in view of the present specification, it would be clear to those skilled in the art that the exemplary structure, material or acts described above correspond to the correction means, such that claim 1 is definite.

It is also respectfully noted that MPEP §2181 (II) indicates "that unless the means-plus-function language is itself unclear, a claim limitation written in means-plus-function language meets the definiteness requirement in 35 U.S.C. 112, second paragraph, so long as the specification meets the written description requirement in 35 U.S.C. 112, first paragraph." Applicant submits that the language associated with the recited correction means is clear and does not raise a written description issue.

Accordingly, Applicant again submits that claim 1 is definite, along with dependent claims 2, 5 and 6, such that the rejection under 35 U.S.C. 112, second paragraph, should be withdrawn.

35 U.S.C. § 103:

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (U.S. Pat. No. 5,037,613 [hereafter “Shaw”]) in view of Marquiss et al. (U.S. Pat. No. 6,838,051 [hereafter “Marquiss”]).

Shaw is applied for disclosing incubators with a plurality of element chambers (66) arranged along the outer periphery of an incubator rotor (64). Applicant again thanks the Examiner for the courtesies extended during the May 11, 2006 interview and for taking time to discuss the rejection and the issues noted in the below remarks.

First, Applicant respectfully submits that that the structure of Marquiss does not correspond to the claimed correction means. Second, the Examiner cannot ignore the claimed function associated with the correction means. The function associated with the correction means includes the entire portion recited in the correction means clause, including “*compensates for fluctuation in the value of the optical density of the dry analysis element in each of the element chambers as measured by the light measuring head generated due to fluctuation in the distance between the light measuring head and the element chamber on the basis of a correction value which has been stored in the correction means, element chamber by element chamber.*” This function is clearly not taught or suggested by Marquiss.

The application of a prior art reference to a means or step plus function feature *requires* that the prior art perform the *identical function* specified in the claim (MPEP § 2182). *If* a prior art reference teaches the identical function specified in the claim, *then* the Examiner carries the initial burden of proof to show that the prior art structure is equivalent to the structure described in the specification, which has been identified as corresponding to the claimed means (MPEP § 2182). For the Examiner’s convenience, a further section of MPEP § 2182 is reproduced:

"Both before and after *Donaldson*, the application of a prior art reference to a means or step plus function limitation requires that the prior art element perform the identical function specified in the claim. [i]f a prior art reference teaches identity of function to that specified in a claim, then under *Donaldson* an examiner carries the initial burden of proof for showing that the prior art structure or step is the same as or equivalent to the structure, material, or acts described in the specification which has been identified as corresponding to the claimed means or step plus function." (Emphasis added.)

See MPEP § 2182, p. 2100-36, first column.

The first part of the test is not met by Marquiss. Marquiss is relied on to disclose a light monitor (5122) used to correct fluctuations in the intensity of light provided by the light sources. The light monitor of Marquiss is not equivalent to the claimed correction means function identified herein. Applicant respectfully takes issue with the grounds of rejection, because it is evident that Marquiss does not perform the identical function specified in the claim.

Instead, Marquiss discloses that:

"Light monitor 5122 is used to correct for fluctuations in the intensity of light provided by the light sources. Such corrections may be performed by reporting detected intensities as a ratio over corresponding times of the luminescence intensity measured by the detector to the excitation light intensity measured by the light monitor. The light monitor also can be programmed to alert the user if the light source fails." (Emphasis added.)

See col. 41, lines 40-48 of Marquiss.

This does not teach or suggest the correction means of claim 1, as would be appreciated by one skilled in the art. The function of claim 1 includes:

"correction means which compensates for fluctuation in the value of the optical density of the dry analysis element in each of the element chambers as measured by the light measuring head generated due to fluctuation in the distance between the light measuring head and the element chamber on the basis of a correction value which has been stored in the correction means, element chamber by element chamber." (Emphasis added.)

The claimed correction means, amongst other things, compensates for fluctuation in a value of an optical density of the dry analysis element. The light monitor 5122 of Marquiss does not compensate for any fluctuation in value of the optical density of a “dry analysis element.” Instead, the light monitor 5122 of Marquiss corrects light intensity of a light source. That is, the light monitor acknowledges if the light source is not proper. However, there is no compensation provided by the light monitor 5122 for the value of the optical density of any dry analysis element, nor are the other functional aspects of the claimed correction means taught or suggested. Marquiss’ light monitor is different, as would be understood by a skilled artisan. Therefore, it is respectfully submitted that Marquiss fails to teach or suggest the features of claim 1, including the correction means, in accordance with 35 U.S.C. § 112, sixth paragraph, such that the rejection should be withdrawn.

Further, the light monitor of Marquiss is not equivalent to the claimed correction means. As noted above, Marquiss does not teach the identical function recited in claim 1. Therefore, the analysis should end at this point. The first prong of analysis cannot be skipped. Nevertheless, the light monitor of Marquiss is different than the claimed correction means and is not equivalent, as would be understood by one skilled in the art, and in view of Marquiss’ teachings.

Accordingly, for at least the reasons set forth above, it is respectfully submitted that Marquiss does not teach or suggest each feature recited in claim 1, such that the rejection therefore under 35 U.S.C. § 103(a) should be withdrawn. The rejection of claim 2, 5 and 6 should be withdrawn at least due to its dependency on claim 1.

With regard to claim 2, the Examiner asserts, that “the manner in which the correction means operates within the device is not sufficiently limiting to make the claims patentable since the limitation is directed to the manner in which the device operates.” Applicant points out that that a functional feature is an attempt to define something by what it does, rather than by what it is. Therefore, such a recitation must be evaluated and considered, just like any other feature of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (see MPEP §2173.05(g)). A functional feature is often used in association

with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step (see *Id*).

Claim 5 recites a position detecting section, wherein the correction means receives a signal from the position detecting section that represents a position of one of the plurality of element chambers. The Examiner asserts that Marquiss teaches a bar code reader (col. 17) which may serve as a position detector to determine the position of the test slide. However, Applicant respectfully submits that Marquiss does not receive a signal from a bar code reader, as recited in claim 5.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

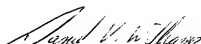
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